

REMARKS

Numbered paragraph 1 of the Detailed Action corresponds to the Examiner's objection to Applicants' amendment filed on February 3, 2005 under 35 U.S.C. § 132. Numbered paragraph 2 of the Detailed Action corresponds to the Examiner's rejection of claims 1-30 under 35 U.S.C. § 103(a).

Specification Objections

The Examiner objects to Applicants' amendment filed on February 3, 2005 under 35 U.S.C. § 132 for introducing new matter into the disclosure. Specifically, the Examiner objects to Applicants' amendment of page 2, line 10 through line 28 as adding new matter. As a result of Applicants' current amendment to the specification, this objection should be withdrawn as moot.

Claim Rejections – 35 U.S.C. § 103

Having noted the Examiner's comment regarding 35 U.S.C. § 103(a), Applicants address 35 U.S.C. § 103 rejections. The Examiner rejects claims 1-30 under 35 U.S.C. § 103(a) as being unpatentable over Godwin U.S. Patent No. 3,453,493 in view of Landis et al. U.S. Patent No. 3,887,254 and Peil U.S. Patent No. 4,806,937. As a result of Applicants' amendments, claims 1-30 should now be allowable.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must *both* be found in the prior art, not in applicant's disclosure. In this case, Applicants argue that the Examiner has not met the criteria for finding of obviousness because nowhere in the cited art is there a suggestion to combine the teaching(s) to arrive at the claimed invention nor is there any reasonable expectation of success.

It is well known that most inventions are composed of elements that *per se* are old and well known. That, however, does not make an invention "obvious" under 35 U.S.C. § 103. The Examiner's attention is respectfully drawn to, for example, *Orthopedic Equip. Co. v. United*

States, 702 F.2d 1005, 1012, 217 USPQ 193 199 (Fed.Cir. 1983), where the Federal Circuit held that “[o]bviousness cannot be established by combining teachings of prior art to produce the claimed combination, absent some teaching or suggestion supporting the combination.” Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (C.C.P.A. 1976).

Also, as stated in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552 (Fed. Cir. 1983), *cert. denied*, *Garlock, Inc. v. W.L. Gore & Assoc.*, 469 U.S. 851, 105 S. Ct. 172, 83 L.Ed.2d 107 (1984):

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Finally, even if the constituents of an invention may be old, if the result would not have been obvious at the time of the invention, then the result may be patentable. *Reiner v. I. Leon Co.*, 285 F.2d 501, 128 USPQ 25, (2d.Cir. 1960), *cert. denied*, *I. Leon Co. v. Reiner*, 336 U.S. 978, 81 S. Ct., 1918, 6 L.Ed.2d 1268 (1961).

In each case, a patent examiner must apply the standard of patentability enunciated in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). In order to determine the basis for the § 103 rejection, the Examiner must:

- (A) Determine the scope and contents of the prior art;
- (B) Ascertain the differences between the prior art and the claims in issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate evidence of secondary considerations.

Furthermore, when applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- 1) The claimed invention must be considered as a whole;

- 2) The references must be considered as a whole and must suggest the desirability and the obviousness of making the combination;
- 3) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- 4) Reasonable expectation of success is the standard with which obviousness is determined.

Regarding claims 1, 8, 12, and 18, Applicants' reel comprises a means to take up slack in the conductor and maintain a shortest fractional conductor length. However, Landis does not teach or suggest that Landis's reel comprises a means to take up slack in the conductor and thereby minimize cable length.

Additionally, Applicants assert that there would be no suggestion or motivation to one skilled in the art to combine Landis and Peil with Godwin. Godwin discloses a grounding system comprising two cables of fixed length connected to a floating roof of a tank. Column 2, lines 15-22. Landis discloses a system to facilitate the convenient, temporary grounding of a vehicle in order to increase the likelihood that a user will properly ground the vehicle and to reduce "clutter and general disarray" associated with prior art vehicle grounding systems. *See* column 1, lines 1-46; column 3, line 64 – column 4, line 10. Landis does not suggest using Landis's system as part of a ground system for a permanent structure, such as a storage tank. Furthermore, Landis does not even mention overall system impedance – Landis merely teaches that the impedance of the shunts is significantly lower than that of the bearings. Column 3, lines 16-63. Therefore, because Landis teaches a system to facilitate convenient, temporary grounding of a vehicle and does not teach a system to minimize impedance of a grounding system of a fixed structure, Applicants assert there is no motivation or suggestion to combine Landis with Godwin in order to produce a low impedance grounding system like Applicants' system.

Peil comprises a means to reduce impedance at high frequencies. However, Peil's low impedance system consists of a power distribution system comprising laminated, multi-circuit bus bars with loads distributed along the bus bars. Column 4, lines 29-39; column 4, lines 62-65; column 5, lines 5-25. In contrast, Applicants' low impedance connection comprises a cable connecting a floating roof to a tank structure – not a multi-circuit power distribution system with

distributed loads. Therefore, Applicants' assert that there is no motivation or suggestion to combine Peil's power distribution system with Godwin in order to produce a low impedance grounding system like Applicants' system.

With respect to the remaining claims, these claims directly or indirectly depend on amended base claims 1, 8, 12, or 18. Therefore, the remaining claims should now be allowable.

Applicants note the Examiner's comments at paragraphs 3 and 4 of the Detailed Action.

Information Disclosure Citation

The Examiner requests documentation regarding a prior sale of an earlier and different test model in Israel on or about July 28, 1999. Applicants offer the Examiner an Affidavit of Roy B. Carpenter, Jr. and four Sales Orders to fulfill this request. If the Examiner requests additional information or should have any questions, the Examiner is invited to contact Applicants' representative as set forth below to expedite prosecution.

In view of the above, Applicants respectfully request the Examiner to pass this application to allowance.

Respectfully submitted,



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Date: 9-22-05